

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

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KASIM SULTON,

Plaintiff,

01 Civ. 8179 (JSM)

-v.-

OPINION AND ORDER

KIRSTEN C. ASHLEY,
d/b/a KASIMONLINE.COM,
MnM MANAGEMENT or MIDGE AND MO
MANAGEMENT,

Defendant.

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JOHN S. MARTIN, Jr., District Judge:

Plaintiff Kasim Sulton brings this action against Defendant Kirsten Ashley, alleging that Defendant has unlawfully used Plaintiff's name, signature, and likeness, and has engaged in cyberpiracy and false designations and representations in violation of the Lanham Act and laws of the State of New York. Defendant, appearing *pro se*, seeks to dismiss or stay the action on the grounds that the subject matter of the action is duplicative of a contract action currently pending in Nevada state court and because the Court lacks personal jurisdiction over the Defendant.

Facts

For the purposes of this motion, all factual disputes are to be resolved in Plaintiff's favor. See A.I. Trade Finance, Inc. v. Petra Bank, 989 F.2d 76, 79-80 (2d Cir. 1993). Plaintiff Kasim Sulton, known to many fans simply as "Kasim," is a musician and songwriter who has accompanied numerous popular musicians and performed solo for over twenty-five years. Plaintiff is a resident of Staten Island, New York. Defendant, a resident of Nevada, was introduced to Plaintiff's music by a friend. While the explicit details that Defendant has provided concerning their relationship are not relevant to this motion, it is clear that Defendant met Plaintiff in person in June 2000, on the day of one of his performances. Plaintiff and Defendant remained in contact via the internet and the correspondence eventually turned to the subject of Plaintiff's solo career. Defendant offered to assist Plaintiff with managing and promoting his solo career, and on December 17, 2001, Plaintiff granted Defendant permission to do so.

According to Plaintiff, around January 2001, Defendant started the website "kasimonline.com." The website was created in Nevada. Plaintiff and Defendant settled on content for a biography and decided to use Plaintiff's signature as the logo for the site. The website has information about the Plaintiff, tour information, photographs, and other items of interest for

fans. In a matter of months the relationship between the parties began to deteriorate and in early March 2001, Plaintiff informed Defendant that he was terminating their business relationship. Despite this falling out, Defendant maintained exclusive control of the website and continues to call it the "Original Official Website of Kasim Sulton." Plaintiff then launched a new website, KasimSulton.com. Plaintiff alleges that Defendant began posting negative commentary about Plaintiff on the kasimonline.com website and sent disparaging emails to the website mailing list, all the while claiming that kasimonline.com is an "official" website, affiliated with Kasim Sulton. Plaintiff claims that Defendant's continued control of the website and her representations about the Plaintiff have resulted in the loss of many fans.

Understanding that the business relationship had been terminated March 2001, Defendant offered to relinquish control of the website in return for reimbursement for the services that she had provided to date. In reply, Plaintiff's attorney informed Defendant that pending a response from Plaintiff, she should cease "from her ongoing misrepresentations of Mr. Sulton's name and likeness" and "her willful infringement of registered copyrights." (Siegel Aff. Ex 2.) Furthermore, Plaintiff instructed Defendant that she was not entitled to view and record Plaintiff's upcoming New York performance on April 7, 2001. Defendant, however, attended the performance for the purpose of

public relations, advertising KasimOnline.com and other upcoming shows, and video taping the performance for use on the website. (Siegel Aff. Ex. 1). Defendant continues to operate and maintain the website, despite Plaintiff's instruction that she is no longer authorized or otherwise permitted to use his name or likeness for any purpose.

On April 19, 2001, Defendant Ashley filed a complaint against Plaintiff Sulton in the Clark County District Court, Nevada. The case concerns the business relationship as well as certain matters following the termination, such as Plaintiff Sulton's alleged misrepresentations about Defendant Ashley's business reputation and Plaintiff's alleged attempt to convert the website. In the state action, Defendant Ashley seeks, *inter alia*, reimbursement for the services that she provided to Plaintiff during their business relationship.

Subsequently, on August 30, 2001, Plaintiff filed this action against Defendant, claiming that Defendant's continued operation of the website, after the termination of the business relationship, has violated Plaintiff's rights and injured his business. Specifically, Plaintiff asserts claims of cyberpiracy in violation of 15 U.S.C. § 1125(d), false designation of origin in violation of 15 U.S.C. § 1125(a), and violations of privacy and business rights under New York law.

Discussion

Defendant seeks to have this action dismissed, or, in the alternative, stayed on the grounds that the subject matter is duplicative of that at issue in the Nevada state court proceeding and also argues that the Court lacks jurisdiction over her person. The Court will first consider the matter of personal jurisdiction.

I. Personal Jurisdiction

To survive a motion to dismiss, Plaintiff is required to make only a prima facie case for personal jurisdiction. See A.I. Trade Finance, 989 F.2d at 79-80. Plaintiff contends that New York's long-arm statute provides three grounds on which personal jurisdiction may rest. First, Plaintiff claims that Defendant committed a tortious act within the state. See N.Y. C.P.L.R. § 302(a)(2) (2001). Second, Plaintiff argues that jurisdiction is proper under C.P.L.R. § 302(a)(3) because Defendant committed a tortious act outside the state which caused an injury inside New York. Lastly, Plaintiff argues that this Court has personal jurisdiction over Defendant because she transacted business within New York, bringing Defendant within the scope of C.P.L.R. § 302(a)(1). Since jurisdiction is proper under C.P.L.R. § 302(a)(1), the court need not reach plaintiff's alternative arguments.

C.P.L.R. § 302(a)(1) provides jurisdiction over a person who "transacts any business within the state or contracts anywhere to supply goods or services in the state." N.Y. C.P.L.R. § 302(a)(1). In determining whether jurisdiction over a defendant has been adequately plead and fairly asserted, courts examine the totality of the circumstances. See Pilates, Inc. v. Pilates Inst., Inc., 891 F. Supp. 175, 179 (S.D.N.Y. 1995). Where a party purposely projects herself into New York, personal jurisdiction may be exercised where there is a strong nexus between the plaintiff's cause of action and the defendant's in-state conduct. See Citigroup Inc. v. City Holding Co., 97 F. Supp. 2d 549, 564 (S.D.N.Y. 2000); Klagsbrun v. Ross, No. 93 Civ. 7709, 1995 WL 43664, at *3-4 (S.D.N.Y. Feb. 3, 1995).

Here, Defendant does not deny that she traveled to New York to attend two concerts by Plaintiff, that she reported on these concert on the website, and that either she or someone acting on her behalf took pictures at one of these new York concerts which were posted on the website. Thus, while the allegedly infringing website was created and is maintained in Nevada,¹ the defendant engaged in substantial purposeful activity in New York that

¹The creation and maintenance of a website outside of New York cannot alone confer jurisdiction over Defendant in a trademark infringement case because the injury in such a case is the creation of the website and the place of the tort is where the website was created. Bensusan Restaurant Corp. v. King, 126 F.3d 25, 29 (2d. Cir. 1997); Telebyte, Inc. v. Kendaco, Inc., 105 F. Supp. 2d. 131, 134 (E.D.N.Y. 2000).

related to her operation of the website. This activity, coupled with Defendant's letter to Plaintiff in New York, offering to relinquish control of the website to Plaintiff in return for a payment, is sufficient to satisfy the jurisdictional requirements of C.P.L.R. § 301(a)(1).

Personal jurisdiction under New York's long-arm statute also meets the requirements of constitutional due process that the defendant have "certain minimum contacts with [the forum] such that the maintenance of the suit does not offend traditional notions of fair play and substantial justice." International Shoe, 326 U.S. at 316, 66 S.Ct. 154 (citation and internal quotation marks omitted); World-Wide Volkswagen Corp. v. Woodson, 444 U.S. 286, 292, 100 S.Ct. 559, 62 L.Ed.2d 490 (1980); Chew v. Dietrich, 143 F.3d 24, 28 (2d Cir.1998). Defendant's trip to New York to attend and photograph plaintiff's concerts meet the minimum contacts requirement of due process.

II. Duplicative Proceedings

Defendant argues that the Court should dismiss or stay this action on the ground that the subject matter is duplicative of a matter currently pending between the parties in a Nevada state court. Although federal courts have a "virtually unflagging obligation" to exercise their jurisdiction, dismissal or abstention pending an action in state court may be appropriate in

exceptional circumstances. Colorado River Water Conservation Dist. v. United States, 424 U.S. 800, 817-818 (1976); Village of Westfield v. Welch's, 170 F.3d 116, 120 (2d Cir. 1999). Here, the balance of considerations militates in favor of the Court exercising its jurisdiction.

To determine if abstention is appropriate, the Court must weigh six factors, "with the balance heavily weighted in favor of the exercise of jurisdiction." Moses H. Cone Mem'l Hosp. v. Mercury Constr. Corp., 460 U.S. 1, 16 (1983). "Only the clearest of justifications will warrant dismissal." Colorado River, 424 U.S. at 819. The six factors are:

- (1) the assumption of jurisdiction by either court over any res or property;
- (2) the inconvenience of the federal forum;
- (3) the avoidance of piecemeal litigation;
- (4) the order in which jurisdiction was obtained;
- (5) whether state or federal law supplies the rule of decision; and
- (6) whether the state court proceeding will adequately protect the rights of the party seeking to invoke federal jurisdiction.

Welch's, 170 F.3d at 121. No single factor is decisive, see DeCisneros v. Younger, 871 F.2d 305, 307 (2d Cir. 1989), and the list does not operate as a mechanical checklist but "a careful balancing of the important factors as they apply in a given case," Cone, 460 U.S. at 16.

The first factor is not operative here. In fact, the absence of a res points toward the exercise of federal jurisdiction. DeCisneros, 871 F.2d at 307. The second factor similarly does not favor abstention. While the distance between

the state court in Nevada and this court is great enough for it to create an inconvenience for the Defendant, see Colorado River, 424 U.S. at 820, the inconvenience of the action in Nevada is just as great for the New York-based Plaintiff, see S-Fer Int'l Inc. v. Paladion Partners, Ltd., 906 F. Supp. 211, 215 (S.D.N.Y. 1995) ("A zero sum exchange of burdens does not favor a transfer.").

With respect to the third factor, abstention is favored when the state and federal issues are so inextricably linked that a party can face liability in two different forums and inconsistent results can emerge. DeCisneros, 871 F.2d at 308. This situation may arise when some of the parties in the state action are not party to the federal action, and vice-versa. See Id. Here, however, the parties are the same in both actions, and the nature of the claims, though arising from similar facts, are not so fundamentally linked that such piecemeal litigation would result. See Colorado River, 424 U.S. at 816 ("[M]ere potential for conflict in the results of adjudications does not, without more, warrant staying exercise of jurisdiction.").

The fourth factor turns on "how much progress has been made in the two actions." Cone, 460 U.S. at 21. It appears that the Nevada state court is currently considering Defendant Sulton's motion to quash for lack of personal jurisdiction. Because this federal action has progressed neither much farther than the filing of the complaint nor much farther than the state action,

this factor favors abstention. See Colorado River, 424 U.S. at 820; DeCisneros, 871 F.2d at 308.

The last two factors favor exercising federal jurisdiction. Regarding the fifth factor, "[w]hen the applicable substantive law is federal, abstention is disfavored." DeCisneros, 871 F.2d at 308. Here, Plaintiff is stating claims under federal trademark law. The sixth factor is only significant if it militates in favor of federal litigation. Bethlehem Contracting Co. v. Leher/McGovern Inc., 800 F.2d 325, 328 (2d Cir. 1986). Here, given the federal nature of some of Plaintiff's claims, the federal court is in a better position to protect Plaintiff's rights.

Considering that only one of the factors weighs in favor of abstention, the Court determines that it shall not abstain or dismiss this action pending the state court proceeding.

For the foregoing reasons, Defendant's motion is denied.

SO ORDERED.

Dated: New York, New York
January , 2002

John S. Martin, Jr.
U.S.D.J.

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